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EXAMINER
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SHIN, SEONG-AH A

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* GEORGE MIZHEN WANG and LILI NI WANG

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Appeal 2016-000264  
Application 13/219,680<sup>1</sup>  
Technology Center 2600

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Before JOHN A. EVANS, NATHAN A. ENGELS, and SCOTT E. BAIN,  
*Administrative Patent Judges.*

BAIN, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–17, 19, 21, and 22, which constitute all claims pending in the application. Claims 18 and 20 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

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<sup>1</sup> The *pro se* Appeal Brief omits the real party in interest.

STATEMENT OF THE CASE

*The Claimed Invention*

The claimed invention relates to a “phonetic symbol system” using “letters of [the] English Alphabet.” Abstract. Claims 1, 2, and 19 are independent. Claim 1 is illustrative of the invention and the subject matter of the appeal, and reads as follows:

1. A phonetic symbol system comprising:  
a plurality of phonetic symbols,  
wherein each of said phonetic symbols is defined by one or more than one letter of English alphabet, the case or the style of said letter does not affect the sounds of said phonetic symbols, there are vowel phonetic symbols and consonant phonetic symbols of said phonetic symbols, each vowel is distinctively represented by one of said vowel phonetic symbols, and each consonant is distinctively represented by one of said consonant phonetic symbols.

Br. 21 (Claims App.).

*The Rejections on Appeal*

Claims 1–17, 19, 21, and 22 stand rejected under pre-AIA 35 U.S.C. § 112, first paragraph, as failing to enable one of ordinary skill in the art to make and use the invention. Final Act. 5.

Claims 1–17, 19, 21, and 22 stand rejected under pre-AIA 35 U.S.C. § 112, second paragraph, as indefinite. Final Act. 6.

Claims 1–17, 19, 21, and 22 stand rejected under pre-AIA 35 U.S.C. § 101 as directed to non-statutory subject matter. Final Act. 6–7.

Claims 1–5, 14, and 19 stand rejected under pre-AIA 35 U.S.C. § 102(b) as anticipated by Su (US 7,004,758 B2; Feb. 28, 2006). Final Act. 7–9.

Claims 6–13, 15–17, 21, and 22 stand rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Su and Scholastic First Dictionary (Scholastic Inc., 1998). Final Act. 9–11.

### ANALYSIS

We have reviewed the Examiner’s rejections in light of Appellants’ arguments presented in this appeal. Arguments which Appellants could have made but did not make in the Brief are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). On the record before us, we are persuaded the Examiner erred as to the enablement rejection. We are not persuaded of error on the remaining rejections, and as to those rejections, we adopt as our own the findings and reasons set forth in the rejections from which the appeal is taken and in the Examiner’s Answer. We provide the following for highlighting and emphasis.

#### *Rejections Under 35 U.S.C. § 112*

Appellants argue, Br. 5, the Examiner erred in finding the Specification’s “enablement is not commensurate in scope with the claims” and therefore erred in rejecting the claims as not enabled, Final Act. 5. Appellants contend the Specification demonstrates how the claim elements “are represented using the [claimed] phonetic symbol system,” that the Specification “defines all the phonetic symbols,” and that it “also gives examples.” Br. 5.

The Examiner’s Answer is silent regarding the enablement rejection, and does not respond to Appellants’ arguments on that issue. Moreover, the pertinent findings in the Final Office Action appear directed to indefiniteness, non-statutory subject matter, and anticipation, not

enablement. Final Act. 5. Accordingly, we do not sustain the rejection under pre-AIA 35 U.S.C. § 112, first paragraph.

As to the rejection under pre-AIA 35 U.S.C. § 112, second paragraph (indefiniteness), however, we are not persuaded of error. Appellants argue the invention is “claimed . . . the same way” as the prior art Su reference (an issued patent) and is “better,” being “easy for people to learn and use.” Br. 6. None of these arguments, however, are germane to the indefiniteness rejection. *See, e.g., Nautilus, Inc. v. Biosig Instr., Inc.*, 134 S. Ct. 2120, 2124 (2014) (“[A] patent is invalid for indefiniteness if *its claims*, read in light of the *specification* delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”) (emphasis added). As the Examiner finds, Final Act. 6, Appellants’ claims are “narrative in form and replete with indefinite language” that fails to apprise the scope of the claims. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211–12 (BPAI 2008) (precedential); *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008) (“it is highly desirable that patent examiners demand that applicants” resolve any “ambiguity in the patent claims . . . during prosecution”).

Accordingly, we sustain the rejection of claims 1–17, 19, 21, and 22 under pre-AIA 35 U.S.C. § 112, second paragraph, as indefinite.

*Rejection Under 35 U.S.C. § 101*

Appellants argue the Examiner erred in finding the claims are directed to non-statutory subject matter, contending the claimed phonetic symbol

system is “functional” and “tangible through things such as voice, writing, and other forms.” Br. 7.<sup>2</sup> These arguments are not persuasive of error.

As the Examiner finds, the “phonetic symbol system” recited in claim 1 is not a “process, machine, manufacture or composition of matter,” *i.e.*, is not within one of the categories of patentable subject matter set forth in section 101. Ans. 4. Moreover, we discern no error in the Examiner’s finding that the claimed “system” is directed to the abstract idea of “defining” phonetic symbols in language, using strings of English letters. *Id.* at 5. It is well established that such “abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

For the foregoing reasons, we sustain the rejection of claims 1–17, 19, 21, and 22 under pre-AIA 35 U.S.C. § 101.

*Rejection Under 35 U.S.C. § 102(b)*

Appellants argue the Examiner erred in finding Su anticipates claim 1 because “[Appellants’] invention use[s] letters of [the] English alphabet while Su’s phonetic symbols use[s] letters of [the] English alphabet *and other characters*.” Br. 7 (emphasis added). We are not persuaded of error.

As the Examiner finds, claim 1 does not require that *all* phonetic symbols in claim 1 use *only* English letters. Ans. 6. Claim 1 only recites “a plurality” of phonetic symbols, each defined by one or more English letters. *Id.*; *see also In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (claim terms are given their “their broadest reasonable interpretation consistent with the specification”). As the Examiner finds, Su

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<sup>2</sup> Appellants argue the claims as a group, and we choose claim 1 as representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(iv).

discloses this plurality of phonetic symbols. Ans. 6; Su col. 2, ll. 12–41, col. 3 (tables), col. 5 (tables).

For the same reasons explained above regarding claim 1, we also discern no error regarding the remaining claims. Appellants argue repeatedly that the claimed “invention is fundamentally different from Su’s phonetic symbol system [because] Su uses non-alphabetic characters.” Br. 8–11. Appellants, however, base their arguments on a general characterization of the Specification rather than limitations recited in the claims. *See, e.g., E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (although claims are interpreted “in view of the specification,” we do not “import[] limitations from the specification into the claims”).

Accordingly, we sustain the rejections of claims 1–5, 14, and 19 under pre-AIA 35 U.S.C. § 102(b) as anticipated by Su.

*Rejection Under 35 U.S.C. § 103(a)*

Appellants repeat the same arguments for obviousness as for anticipation. *See* Br. 11–19. Specifically, Appellants contend the claimed invention is “fundamentally different” from the prior art because Su uses “non-alphabetic characters” in addition to English letters, and that the claimed invention has many advantages. *Id.* at 11. For the reasons discussed above and set forth in the Examiner’s Answer, Ans. 13–28, we are not persuaded of error.

Accordingly, we sustain the rejection of claims 6–13, 15–17, 21, and 22 under pre-AIA 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner’s rejections of claims 1–17, 19, 21, and 22.

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Application 13/219,680

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1). *See* 37 C.F.R. § 41.50(f).

AFFIRMED